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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,998

07/30/2001

Marco Steiger

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1503

24126

7590

11/24/2009

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EXAMINER

MCDONALD, SHANTESE L

ART UNIT

PAPER NUMBER

3723

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/917,998	<b>Applicant(s)</b> STEIGER ET AL.	
	<b>Examiner</b> SHANTESE MCDONALD	<b>Art Unit</b> 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-9,13-17 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9,13-17 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-9, 11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Miller and Fieni.

Fletcher et al. teaches a tool for use with a manually operable material removal apparatus comprising a flat elongated member, 10, having a rearward first section, 12, provided with a hole, 16, which allows the member to be mounted on an output shaft with a fastener having a predetermined thickness, and a forward second section, 8, remote from the first section and including material removing cutting teeth, 2. Fletcher et al. also teaches that cutting teeth are formed by adjoining two straight cutting edge sections at acute angles, (fig. 2). Fletcher et al. also teaches a slot, 24, provided for facilitating removal of cut material, provided in the elongated member between the first and second sections. Fletcher teaches that the elongated member has a substantially constant width at least between the first and second sections, (fig. 1), and the member having a substantially trapeze form outline, (fig. 6a), and the elongated member comprising a third section, disposed between the first and second sections having a first width, at least one of the first and second sections having a second width different from the first width, (fig. 6a). Fletcher teaches all the limitations of the claims except for the

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elongated member being configured with at least one elongated path that facilitates rearward movement, along the path, of material being cut from the workpiece by the cutting edge, as well as removal of the material being cut, and at least one cutting edge having a first and second end and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections, and the acute angle being between 1.4 and 4.6 and 1.5 and 2 degrees, the hole having a shape different from a circle, the hole being a polygon, the elongate member comprising a step intermediate the first and second sections, the step being at least equal to the thickness of the fastener, and having a height being larger than a fastener attached to the output shaft above the hole for fastening the member to the output shaft, Miller teaches elongated member being configured with at least one elongated path that facilitates rearward movement, along the path, of material being cut from the workpiece by the cutting edge, as well as removal of the material being cut, (31,54), and at least one cutting edge having a first and second end and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections, (fig. 5B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Fisher with the above listed limitations taught by Miller, in order to enhance the material cutting and material removal capabilities. Fieni teaches an elongate member comprising a step, 136, intermediate the first, 138, and second, 135, section, (fig. 7). It would have been further obvious to provide the tool of Fisher with a step, as taught by Fieni, in order to enhance the functionality of the tool. It would have been

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further obvious to make the acute angle of Fletcher between 1.5 and 4.6 and 1.5 and 2 degrees, in order to vary the cutting angles and the hole being a shape different from a circle, the hole being a polygon, the step at least equal to the thickness of the fastener, and having a height being larger than a fastener attached to the output shaft above the hole for fastening the member to the output shaft since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. as modified by Miller and Fieni, in further view of Arntz et al.

Fletcher et al. as modified by Miller teaches all the limitations of the claims except for the material removing elements comprising diamonds and corundum. Arntz et al. teaches material removing elements, 35, comprising diamonds and corundum, (col. 4, lines 55-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material removing elements of Fletcher et al. as modified by Miller and Fieni with diamonds and corundum, as taught by Arntz et al. in order to enhance the elements material removing capabilities, and to make them more durable.

### ***Response to Arguments***

Applicant's arguments filed 7/21/09 have been fully considered but they are not persuasive.

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Fletcher teaches a plurality of holes, 16, to facilitate attachment of the blade to an oscillating shaft of a tool, (col. 4, lines 31-35). Fletcher is silent as to what is used to attach the blade to the tool, but it is well known to attach a blade to a shaft of a tool using a fastener. The added limitation claims that the fastener has a predetermined thickness. This is an open ended limitation, since the fastener has not been claimed and a specific thickness has not been claimed. The Applicant argues that the Fieni reference does not disclose or suggest a step that is configured so that the cutting edge of the elongated member extends in the plane of the second section. The Applicant further argues that Fieni does not teach a first section for attachment to an oscillatory output shaft by fastening and that the generally planar nature of blade portion, 114, shows no step at all. The Examiner disagrees. Firstly, Fieni was cited to teach that a relatively planar blade can be formed with a stepped portion between a first and second section. Fieni was cited to teach that one can form the blade of Fisher with stepped portion. In reference to the argument that the planar blade, 114, of Fieni contains not step, the Examiner also disagrees. Fieni teaches that the flat central plate, 135, of the blade portion, 114, has a step, 136, that leads to a slightly elevated landing section, 138, (col. 4, lines 11-13). In reference to the newly added limitation that the step is at least equal to the thickness of the fastener, this is also an open ended limitation, since the fastener has not been claimed, a thickness has not been defined. This limitation can be met as a matter of obvious design choice.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANTESE MCDONALD whose telephone number is (571)272-4486. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.L.M.

November 21, 2009

/Joseph J. Hail, III/

Supervisory Patent Examiner, Art Unit 3723